PATENT
Customer No. 22,852
Attorney Docket No. 09981.0007-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Miodrag CEKIC, et al.	Group Art Unit: 2881
Application No.: 10/632,893	Examiner: Phillip A. Johnston
Filed: August 4, 2003	Confirmation No.: 2897
For: APPARATUS FOR AND METHOD OF TREATING A FLUID	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the Final Office Action mailed December 13, 2005, (hereinafter "Office Action") and pursuant to the July 12, 2005 OG Notice, Applicants respectfully request pre-appeal brief review of the rejections set forth in the Office Action. Applicants submit that the requirements for submitting this Request are met: the application has been twice rejected (March 23, 2005, and December 13, 2005); no amendments are being filed with this Request; a Notice of Appeal and a petition for a two month extension of time accompanies this Request; the Request is timely filed by May 13, 2006; and the Request is five (5) or less pages in length and sets forth legal or factual deficiencies in the above rejections.

I. Status of the Claims

Claims 1-79 are pending and under consideration.

Claims 1-4, 11-22, 27-29, 35, 40-42, and 69-79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 6,590,217 B1 to *Freemen et al.* ("the '217 *Freeman* patent") and U.S. Patent No. 6,626,561 B2 to *Carter et al.* ("the '561 *Carter* patent"). (*See Office Action, pp. 2-4.*)

Claims 5-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the '217 *Freeman* patent and the '561 *Carter* patent in view of U.S. Patent No. 5,136,491 to *Kano* ("the '491 *Kano* patent") and further in view of U.S. Patent No, 6,083,387 to *LeBlanc* et al. ("the '387 *LeBlanc* patent"). (*See Office Action, pp. 4-5.*)

Claims 23-26, 30-34, 36-39, 43-68, 71, and 72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the '217 *Freeman* patent, the '561 *Carter* patent, the '491 *Kano* patent, and the '387 *LeBlanc* patent. (*See Office Action, pp. 6-9.*)

II. Applicants' March 13, 2006, Reply to the Office Action and the April 18, 2006, Advisory Action

The rejection of all pending claims is premised on the combination of the '217 *Freeman* patent and the '561 *Carter* patent as set forth above. The Office, however, has improperly relied upon Applicants' disclosure to find motivation to combine the references. (*See Office Action, pp. 10-13.*) Applicants have pointed out in detail why one skilled in the art would not combine the references to achieve the claimed invention. (*See Applicants' March 13, 2006, Reply, pp. 7-12.*) Nonetheless, the claims are improperly rejected on the basis that Applicants' disclosure provides motivation to

combine. (*See Advisory Action, p. 3.*)

III. The rejections of claims 1-79 are not sustainable as the rejections repeatedly, and expressly, rely upon Applicants' disclosure in combining the '561 *Carter* patent and the '217 *Freeman* patent

Put simply, the rejections rely upon impermissible hindsight.

At pages 12-13 of the Office Action, the rejection states that the '561 *Carter* patent and the '217 *Freeman* patent may be combined ***based upon teachings gleaned only from Applicants' claims*** (Office Action, pp. 12-13, emphasis added):

> The examiner has interpreted *from the applicant's claims above* and the Carter (561) references above, *that adjusting the position of the source away from the focal point of the reflector is performed by both the applicant and Carter (561) to obtain the same result*: i.e., to provide uniform irradiation distribution of the sample, which is governed by the same fundamental principle of optics, "depth of field".

In the Advisory Action mailed April 18, 2006, the Office responds to the above deficiency in the Office Action—and maintains the rejection of claims 1-79—by repeating the reliance ***upon the teachings gleaned only from Applicants' disclosure:***

> The [March 13, 2006, Reply] has been considered but does NOT place the application in condition for allowance because: In response to applicants argument regarding the examiners use of improper hindsight reasoning; the examiner has specifically taken into account only knowledge which was within the level of ordinary skill in the art at the time the invention was made, by particularly pointing out *that the applicants disclosure, **in concert with** the cited prior art* each contain knowledge of the basic optical principles utilized by one of ordinary skill in the art of reflector shapes and surfaces used to provide a desired light flux at a desired location; for example the UV sterilization art. In so doing the examiner has attempted to point out that one of ordinary skill in the subject art would necessarily understand defocusing principles in order to disclose focusing principles, and vice versa.

In view of the express—and repeated—reliance upon Applicants' disclosure, Applicants respectfully submit that the rejections genuinely (and improperly) rely upon Applicants' claims and disclosure in fashioning a rejection over the cited prior art under 35 USC § 103. Such a rejection is not sustainable on appeal.

In view of the above circumstance, as well as the goals of the Pre-Appeal Brief Conference Pilot Program as expressed in the July 12, 2005 OG Notice, Applicants respectfully submit that the present Request is the appropriate, and efficient, manner for the withdrawal of the improper rejections. Specifically, where the rejections clearly and repeatedly cite to Applicants' claims (Office Action, pp. 10-12) and Applicants' disclosure (April 18, 2006, Advisory Action, p. 2) in support of a purported combination of references used to reject all of Applicants' seventy-nine claims, Applicants should not be forced to go through the time and expense of preparing an Appeal Brief for the seventy-nine claims at issue simply to have the Office later recognize the improper basis for the rejections and (potentially) re-open prosecution on the merits.

In this regard, Applicants respectfully submit that the rejections' reliance on Applicants' disclosure is—while improper—nevertheless, genuine. Specifically, as set forth in Applicants' March 13, 2006, Reply, Applicants submit that there is no motivation (other than may be gleaned from Applicants' own disclosure) to combine the '217 *Freeman* patent and the '561 *Carter* patent as suggested in the text of the rejections. In fact, Applicants have submitted detailed reasons showing that the '217 *Freeman* patent teaches against any combination with the '561 *Carter* patent. (See Applicants' March 13, 2006, Reply, pp. 7-12.)

IV. Conclusion

As a result of at least the above-identified legal and factual errors in the rejections of claims 1-79, Applicants submit that the rejections fail to establish a *prima facie* case of obviousness of claims 1-79 under 35 U.S.C. § 103(a). Consequently, Applicants submit that the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed pursuant to the July 12, 2005 OG Notice authorizing this Request.

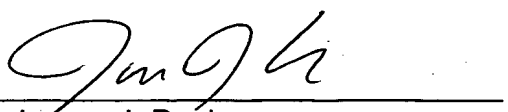
Further still, and without limitation, Applicants note that the rejections have failed to address all elements recited in dependent claims 8 and 9 (see Applicants March 13, 2006, Reply, pp. 18-19); and the rejections have failed to address all elements recited in dependent claims 25, 26, 31, 39, 50, 57-59, 60-62, 72, and 74 (see Applicants March 13, 2006, Reply, pp. 19-23). Accordingly, Applicants submit that the rejection of claims 8, 9, 25, 26, 31, 39, 50, 57-59, 60-62, 72, and 74 under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed pursuant to the July 12, 2005 OG Notice authorizing this Request.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 11, 2006

By: 
James J. Boyle
Reg. No. 46,570